

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

As a preliminary matter, Applicant notes the Office Action's indication that the finality of the Office Action dated November 13, 2007 has been withdrawn pursuant to 37 CFR 1.114 and Applicant's submission filed on February 13, 2008 has been entered. In addition, Applicant appreciates the Office Action's indication that Applicant's arguments with respect to the amended claim language in the submission of February 13, 2008, have been fully considered and are persuasive, thus causing the rejection to be withdrawn.

In the present Office Action, claims 1-12, 17, 20, 21 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,836,843 to Seroussi et al. (hereinafter "Seroussi") in view of U.S. Patent No. 5,948,064 to Bertram et al. (hereinafter "Bertram"). Claims 18, 19, 22 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Seroussi in view of Bertram in view of U.S. Patent No. 6,400,997 to Rapp.

By this amendment, claims 1 and 7 have been amended to further define the subject matter Applicant regards as the invention as discussed in greater detail below. Claims 2-6, 8-12 and 17-24 remain unchanged in the application.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier. After amending the claims as set forth above, claims 1-12 and 17-24 remain pending in this application for consideration.

Applicant respectfully submits that the claims are patentably distinguishable over the cited references as required by §103. Applicant further submits that none of the cited references, whether considered alone or in combination, discloses Applicant's claimed image processing apparatus *wherein when a user has been away from the image processing apparatus for a predetermined time or more, while being in the personal operation mode, the mode switching section switches the operation mode from the personal operation mode*

*into the public operation mode and displays on the display section, a screen representation to accept operation inputs by an indefinite number of users* as now required by independent claim 1. Amended independent claim 7 is directed to a computer-readable medium which addresses similar concerns as independent claim 1 and includes the same patentable feature and arrangement. By contrast, the cited references fail to disclose, teach or suggest this claimed feature and arrangement. Accordingly, independent claims 1 and 7 and claims dependent therefrom are patentably distinguishable over the cited references. This distinction will be further described below.

### **THE CLAIMS DISTINGUISH OVER THE CITED REFERENCES**

Claims 1-12, 17, 20, 21 and 24 stand rejected as being unpatentable over Seroussi and Bertram and claims 18, 19, 22 and 23 stand rejected as being unpatentable over Seroussi, Bertram and Rapp. Applicant respectfully traverses the rejections of these claims, and submits that these claims are allowable for at least the following reasons.

The framework for the objective analysis for determining obviousness under §103 requires:

1. Determining the scope and content of the prior art;
2. Ascertaining the differences between the claimed invention and the prior art;
3. Resolving the level of ordinary skill in the pertinent art; and
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

*Teleflex, Inc. v. KSR Int'l Co.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). In order to establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See MPEP §2143.03.

### **The Cited References Do Not Suggest All Claim Recitations**

The cited references do not meet one of the requirements of MPEP § 2143, which is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Embodiments of the present invention are directed to either an image processing apparatus or a computer-readable medium. The image processing apparatus according to amended independent claim 1 includes a user authentication section, an operation mode setting section, a mode switching section and a personal information processing section. The user authentication section acquires ID information to identify each user from among a plurality of users, and performs user authentication based on the ID information while the operation mode setting section is configured to selectively set, as an operation mode that sets a work environment for operation inputs, between a personal operation mode to permit each user to operate individually and a public operation mode to permit an indefinite number of users to operate. The mode switching section, when a user is authenticated in the user authentication section, switches the operation mode from the public operation mode into the personal operation mode for the authenticated user and the personal information processing section performs the processing of personal information relevant to the users corresponding to the ID information acquired by the user authentication section.

According to the operation of the image processing apparatus, when in a personal operation mode, an operation screen is displayed for a user whose personal information has been processed by the personal information processing section, and the operation screen displays information related to the personal information processing section.

According to one embodiment of the present invention as required by amended independent claim 1, ***when a user has been away from the image processing apparatus for a predetermined time or more, while being in the personal operation mode, the mode switching section switches the operation mode from the personal operation mode into the public operation mode and displays on the display section, a screen representation to accept operation inputs by an indefinite number of users.*** Amended independent claim 7 is directed to a computer-readable medium which addresses similar concerns as independent claim 1 and includes the same patentable feature and arrangement. With this arrangement, it

is possible for each user to perform the processing of his or her own personal information while preventing leakage of the user's personal information without disturbing the use of the indefinite number of users to any substantial extent. (Specification, page 17, line 26 through page 18, line 6). Support for the subject matter recited in amended independent claims 1 and 7 can at least be found on page 4, lines 17-25; page 30, lines 10-27 and page 31, lines 11-19 of the present specification. Applicant respectfully submits that the cited references fail to teach or suggest this claimed feature and arrangement as well as the benefits provided.

The primary reference of Seroussi is directed to a security system based on a tamper resistant badge that becomes deactivated if the badge is removed from the person authorized to wear the badge (Seroussi, abstract, lines 1-3). The Office Action alleges that Seroussi discloses each of the features of independent claims 1 and 7 except for the claimed personal information processing section and the display of an operation screen with information related to the personal information processing section. The Office Action at page 4 then relies on the Bertram reference to cure these deficiencies. Applicant respectfully disagrees.

Even assuming arguendo that Bertram discloses the claimed features indicated above, Applicant respectfully submits that the Seroussi reference fails to disclose, teach or suggest *wherein when a user has been away from the image processing apparatus for a predetermined time or more, while being in the personal operation mode, the mode switching section switches the operation mode from the personal operation mode into the public operation mode and displays on the display section, a screen representation to accept operation inputs by an indefinite number of users* as now required by independent claims 1 and 7. As stated in the previous response, Seroussi does not disclose an operation screen or any type of display for a user whose personal information has been processed. In fact, there is no mention or teaching of a display in Seroussi. Rather, Seroussi utilizes transceivers such as RF sensors or light-based systems to enable communication between the badge and the computer, instead of display screens (column 10, lines 38-48). In failing to teach an operation screen that displays information for a user, Seroussi also fails to disclose, teach or suggest the new recited subject matter of independent claims 1 and 7.

Although Bertram may disclose a personalized desktop presented to a user, this reference fails to disclose, teach or suggest *wherein when a user has been away from the image processing apparatus for a predetermined time or more, while being in the personal operation mode, the mode switching section switches the operation mode from the personal operation mode into the public operation mode and displays on the display section, a screen representation to accept operation inputs by an indefinite number of users* as now required by independent claims 1 and 7. There is absolutely nothing in Bertram that even remotely suggests switching from a personal operation mode to a public operation mode, based on the user being away from the image forming apparatus for a predetermined time. This shortcoming in Seroussi and Bertram defines at least one patentable deficiency in the references. The Rapp reference was relied upon to address features recited in some of the dependent claims. Applicant respectfully submits that the Rapp reference also fails to disclose, teach or suggest this claimed feature and arrangement and was not cited for that purpose.

In view of the fact that the cited references, whether considered alone or in combination do not disclose this claimed feature and arrangement indicated above, these references cannot be said to render obvious the invention which is the subject matter of independent claims 1 and 7. Thus, independent claims 1 and 7 are allowable.

Since independent claims 1 and 7 are allowable, claims dependent therefrom, namely claims 2-6, 8-12 and 17-24 are also allowable by virtue of their direct or indirect dependence from allowable independent claims 1 and 7 and for containing other patentable features. Further remarks regarding the asserted relationship between any of the claims and the cited reference are not necessary in view of their allowability. Applicant's silence as to the Office Action's comments is not indicative of being in acquiescence to the stated grounds of rejection.

In sum, one of the requirements of MPEP § 2143 is not satisfied in the Office Action with respect to any of the claims rejected as obvious because the cited references do not teach each and every element of the present invention. Thus, the present claims are allowable.

The Level of Ordinary Skill In the Art has Incorrectly Been Ascertained

*KSR* did not repeal the *Graham v. John Deere Co.* factors - just the opposite, it reaffirmed them. One of those factors is the requirement that the PTO must resolve the level of ordinary skill in the pertinent art. It is respectfully submitted that the PTO presumes a higher level of skill of the ordinary artisan in this art than was actually present at the time of the invention.

The ordinary artisan would not have had a level of skill sufficient to render the invention obvious to that ordinary artisan. Specifically, before the disclosure of the present invention, the ordinary artisan would not have had the skill to predict that the features of Seroussi could be modified in accordance with Bertram as is asserted in the Office Action. To the contrary, only the innovator would have had the skill necessary to predict such modification. The ordinary artisan would not have had the skills to arrive at the present invention without instruction from the innovator. The Office Action is silent in regard to addressing the requisite *Graham* factors.

Lack of Sufficiently Articulated Rationale to Modify or Combine the References

The Office Action fails to meet the requirement of providing a sufficiently articulated rationale to combine Seroussi and Bertram.

The Supreme Court in *KSR* stated that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the art...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR* at 1741. In addition, the Court in *KSR* stated that a reason to combine

elements should be made explicit. *Id.* at 1740-41.<sup>1</sup> Indeed, the Court approvingly cited *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006), for requiring an articulated reason. *Id.* at 1741.<sup>2</sup>

Seroussi is devoid of any reason why one of skill in the art would incorporate the teachings of Bertram into Seroussi. The Office Action at page 4 states that combining Seroussi and Bertram would allow the user to “logon from any machine in the network and have his or her ‘desktop’ the same, irrespective of the particular machine from which the logon is effected.” Thus, the proffered motivation, even assuming that the underlying results do in fact occur from the general implementation of the teachings of Bertram, does not mean that the ordinary artisan would have incorporated the features of Bertram into Seroussi’s system.

Thus, the PTO has not properly articulated a reason for why one with ordinary skill in the art would combine the teachings of Seroussi and Bertram. Because the PTO has not provided sufficient reasons to combine the teachings of Seroussi and Bertram, any rejection based on this combination is improper. Accordingly, the present claims are not rendered unpatentable over the prior art.

Applicant respectfully submits that independent claims 1 and 7 and claims dependent therefrom are patentably distinguishable over the cited references and thus, allowable. Further remarks regarding the asserted relationship between any of the claims and the cited references are not necessary in view of their allowability. Applicant’s silence as to the Office Action’s comments is not indicative of being in acquiescence to the stated grounds of rejection.

### **CONCLUSION**

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<sup>1</sup> “Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.” *Id.* at 1740-41.

<sup>2</sup> “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” *Id.* at 1741.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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